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COMMENTS: Please file the attached Petition in Application **10/621,433** (Docket No. D-1116 R1 CIP).

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CERTIFICATION UNDER 37 C.F.R. SECTIONS 1.8(a) AND 1.6(d)

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D-1116 R1 CIP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of		
Hanna, et al.		
Application No.: **10/621,433**		Art Unit 3693
Confirmation No.: **1731**		
		Primary Examiner
Filed: **July 16, 2003**		Jocelyn Greimel
Title: **Automated Banking Apparatus and Method**		

Director of Technology Center 3600
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Kindly enter the following petition without prejudice, which is being submitted within two months of the Advisory Action dated December 13, 2007. The Advisory Action was in response to a Request (filed November 19, 2007) for withdrawal of a premature final rejection.

PETITION FOR WITHDRAWAL OF PREMATURE FINAL REJECTION AND FOR ENTRY OF AMENDMENTS

Applicants respectfully submit that the final rejection dated 11/02/2007 should be withdrawn as it is premature and legally improper. Thus, the amendments dated 10/05/2007 and 11/19/2007 are entitled entry.

Background

The following dates and papers are associated with this application:

1. 08/07/2007 1st Final rejection
2. 10/05/2007 Amendment after final rejection
3. 11/02/2007 2nd Final rejection
4. 11/19/2007 Request for withdrawal of a premature final rejection; and Amendment
5. 12/13/2007 Advisory Action denying the Request dated 11/19/2007

Intent of Petition

Applicants petition that:

(1) their amendment dated 10/05/2007 be rightfully entered;

(2) the premature Final rejection dated 11/02/2007 be withdrawn; and

(3) their amendment dated 11/19/2007 be rightfully entered.

The Amendment dated 10/05/2007 is legally entitled to entry

With regard to the 10/05/2007 Amendment, the 2nd Final rejection states (at page 2, first paragraph) that "The newly submitted amendments will not be entered". Yet the Office provides no legal basis for denying entry of the 10/05/2007 Amendment. Nor can it. Nor does the Office's PAIR system indicate that entry thereof was denied or that the required form PTOL-303 (Advisory Action) was used by the Office.

MPEP § 706.07(e) makes clear that if the 1st Final rejection is withdrawn, which had to occur in order to make the 2nd Final rejection, then all prior amendments (which includes the 10/05/2007 Amendment) filed in response to the 1st Final rejection are entitled unhindered entry. Thus, Applicants respectfully request that their 10/05/2007 Amendment be rightfully entered.

The 2nd Final rejection is premature

Scenario 1 (the Amendment dated 10/05/2007 is entitled entry)

If the Amendment dated 10/05/2007 is entitled entry (for the reasons previously discussed), then the 2nd final rejection (dated 11/02/2007) is *prima facie* premature. For example, the 2nd final rejection does not take into consideration all pending claims, especially claims 35-39 added in the Amendment dated 10/05/2007.

Scenario 2 (the Amendment dated 10/05/2007 is not entitled entry)

It is well settled that the Office cannot change rejections while keeping prosecution closed. Yet this would be the situation if the Amendment dated 10/05/2007 was not entered.

The rejections set forth in the 1st Final rejection (08/07/2007) differ from those in the 2nd Final rejection (dated 11/02/2007). For example, claims 33-34 were newly rejected in the 2nd Final rejection. These same claims were not rejected in the 1st Final rejection.

The record shows that the 1st Final rejection did not set forth any rejection of pending claims 33-34. The USPTO requires that all claims being rejected be inserted in a statement of rejection, which is followed by a body of the rejection. Note MPEP form paragraph 7.15. Also, 37 CFR 1.104(c)(2) requires that "each rejected claim" must be clearly specified. Likewise, see *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970) and MPEP § 706.02(j). Claims 33-34 did not appear in any statement of rejection, nor were they rejected, nor did the Office explain how they would be rejected. One skilled in the art of patent prosecution would have concluded that claims 33-34 were considered allowed by the Office in the 1st Final rejection.

MPEP 706.07(a) states:

> "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's *amendment of the claims* nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)."

Applicants respectfully submit that if their Amendment dated 10/05/2007 was not entered, then there is no valid basis for the finality of the rejection dated 11/02/2007. As no amendment was entered, the 2nd final rejection could not have been "necessitated by applicant's amendment of the claims". As no information disclosure statement was filed, the 2nd final rejection could not have been "based on information submitted in an information disclosure statement". It follows that the 2nd Final rejection is a premature final rejection and is legally improper.

Scenario 1 and Scenario 2 both result in a premature final rejection

Regardless of Scenario 1 or Scenario 2, the record shows that the conditions did not meet the legal criteria for the Office to apply a Final rejection on 11/02/2007. The Office is committing prejudicial error by depriving Applicants of their administrative due process rights, i.e., timely notice of the Examiner's position and opportunity for unhindered response thereto. Applicants have not been given an opportunity in accordance with 37 C.F.R. 1.111 to properly rebut the Office's newly imposed ground of rejection.

Conclusion

Appellants' petition should be granted for the reasons presented herein. The undersigned is willing to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,

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